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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,895	12/07/2001	Alfred Preukschat		5243

7590 11/02/2005
DR. MAX FOGIEL
44 MAPLE COURT
HIGHLAND PARK, NJ 08904

EXAMINER

NGUYEN, XUAN LAN T

ART UNIT PAPER NUMBER

3683

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/008,895	Applicant(s) PREUKSCHAT ET AL.	
	Examiner Lan Nguyen	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Seufert.

Re: claims 1 and 10, Seufert shows a regulated dashpot with shock-absorption force controls in figure 1, for motor vehicles, as in the present invention, comprising: at least one flow-regulating system including at least one shock-absorption component for a compression phase and for a decompression phase, at least one valve assembly with two electrically variable flow resistance regulated by regulating valves 68a, 68b, 66a, 66b at least one fixed bypass valve 60 with a non-varying constricted flow cross-section hydraulically and directly paralleling the flow-regulating system, figure 1 shows throttle valve 60 in parallel with both valves 68a, 68b, 66a, 66b as clearly shown in figure 1, whereby the bypass valve has a constant opened flow-through cross section hydraulically in parallel with the regulating valves, said at least one flow regulating system for the compression phase and said at least one flow regulating system for the decompression phase being in the form of said regulating valves with variable flow constriction, said flow resistance being continuous for providing continuous damping

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between soft and hard damping, said bypass valve preventing pressure pulses in damping fluid when said regulating valves transfers rapidly from open to close positions corresponding to upward wheel shocks and sudden wheel accelerations, so that sudden jolts are prevented when shifting between soft and hard damping for comfort in riding in said vehicles, and said bypass valve is integratable into the flow regulating system and having minimal passage for hydraulic fluid and preventing the dashpot from being entirely blocked when the regulating valves are closed, as shown in figure 1, said flow-regulating system for the compression and decompression phases forming main flow channels through said shock-absorption component, said valve assembly with electrically variable flow resistance forming a main valve assembly for said shock-absorption component, said fixed bypass valve 60 having a constant non-adjustable flow cross section, as shown in figure 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seufert.

Re: claim 6, Seufert's regulated dashpot, as rejected in claim 1, lacks the throttle valve 60 being accommodated in a separate unit outside the dashpot and

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communicates with said dashpot through a hydraulic line. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Seufert's dashpot to arrange for throttle valve 60 to be accommodated in a separate unit outside the dashpot and communicates with the dashpot through a hydraulic line so that it would provide easy access to the throttle valve in case of repair. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Re: claim 11, Seufert shows a regulated dashpot with shock-absorption force controls in figure 1, for motor vehicles, as in the present invention, comprising: at least one flow-regulating system including at least one shock-absorption component for a compression phase and for a decompression phase, at least one valve assembly with two electrically variable flow resistance regulated by regulating valves 68a, 68b, 66a, 66b at least one fixed bypass valve 60 with a non-varying constricted flow cross-section hydraulically and directly paralleling the flow-regulating system, figure 1 shows throttle valve 60 in parallel with both valves 68a, 68b, 66a, 66b as clearly shown in figure 1, whereby the bypass valve has a constant opened flow-through cross section hydraulically in parallel with the regulating valves, said at least one flow regulating system for the compression phase and said at least one flow regulating system for the decompression phase being in the form of said regulating valves with variable flow constriction, said flow resistance being continuous for providing continuous damping between soft and hard damping, said bypass valve preventing pressure pulses in damping fluid when said regulating valves transfers rapidly from open to close positions

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corresponding to upward wheel shocks and sudden wheel accelerations, so that sudden jolts are prevented when shifting between soft and hard damping for comfort in riding in said vehicles, and said bypass valve is integratable into the flow regulating system and having minimal passage for hydraulic fluid and preventing the dashpot from being entirely blocked when the regulating valves are closed, as shown in figure 1. Seufert's regulated dashpot, as discussed above, lacks the throttle valve 60 being accommodated in a separate unit outside the dashpot and communicates with said dashpot through a hydraulic line. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Seufert's dashpot to arrange for throttle valve 60 to be accommodated in a separate unit outside the dashpot and communicate with the dashpot through a hydraulic line so that it would provide easy access to the throttle valve in case of repair. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

5. Claims 1, 6, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preukschat et al. (USP 4,986,393) in view of Seufert.

Re: claims 1, 6 and 10, Preukschat et al. show a regulated dashpot with shock-absorption force controls in figure 1c, for motor vehicles, as in the present invention, comprising: at least one flow-regulating system including at least one shock-absorption component for a compression phase and for a decompression phase, at least one valve assembly with two electrically variable flow resistance regulated by regulating valves 8.1, 8.2, 7.1, 7.1.1, 7.1.2, 7.2, 7.2.1, 7.2.2 at least one bypass valve 7.3, figure 1 shows

valve 7.3 in parallel with both valves 8.1, 8.2, 7.1, 7.1.1, 7.1.2, 7.2, 7.2.1, 7.2.2 as clearly shown in figure 1c, said at least one flow regulating system for the compression phase and said at least one flow regulating system for the decompression phase being in the form of said regulating valves with variable flow constriction, said flow resistance being continuous for providing continuous damping between soft and hard damping, said bypass valve preventing pressure pulses in damping fluid when said regulating valves transfers rapidly from open to close positions corresponding to upward wheel shocks and sudden wheel accelerations, so that sudden jolts are prevented when shifting between soft and hard damping for comfort in riding in said vehicles, and said bypass valve is in a separate unit outside of said dashpot and communicate with said dashpot through hydraulic lines, as shown in figure 1c, and having minimal passage for hydraulic fluid and preventing the dashpot from being entirely blocked when the regulating valves are closed, as shown in figure 1c, said flow-regulating system for the compression and decompression phases forming main flow channels through said shock-absorption component, said valve assembly with electrically variable flow resistance forming a main valve assembly for said shock-absorption component, as shown in figure 1c. Preukschat et al. show bypass valve 7.3 as a two way spring biased valve. Seufert teaches a throttle valve 60 with a non-varying constricted, constant opened and constant non-adjustable flow-through cross section in figure 1. Seufert further teaches in column 5, lines 58 and 59, that an art equivalent throttle valve to a non-varying constricted, constant opened and constant non-adjustable flow-through cross section valve is a spring biased valve. It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to have modified Preukschat et al.'s dashpot with a non-varying constricted, constant opened and constant non-adjustable flow-through cross section valve in place of a spring biased valve as taught by Seufert since it is old and well known in the art of dashpot dampening to utilize either a non-varying constricted, constant opened and constant non-adjustable flow-through cross section valve or a spring biased valve; since these two types of valves are considered to be art equivalent and to replace one for the other only requires routine skill in the art as taught by Seufert.

Re: claim 11, the discussion for the rejection of claims 1, 6 and 10 meet all the claimed limitations of claim 11.

Response to Arguments

6. Applicant's arguments filed 7/22/05 have been fully considered but they are not persuasive.

Applicant argues that Seufert does not disclose an arrangement in which there is continuously varying damping by arguing that figures 3b, 3c and 3d do not showing any continuous damping. Claims 1 and 11 claim "said flow resistance being continuous for providing continuous damping between soft and hard damping". As stated by Applicant in the argument, Seufert's system provides damping between soft, medium and hard. It is believed that medium is a continuation between soft and hard. In order to further understanding the logic behind Applicant's argument, the specification was further reviewed to determine the distinction between Applicant's claimed continuous damping

and Seufert's continuous damping, it is found that there are no further explanation nor illustration to describe the meaning of "continuous" to be any different than Seufert's. Hence, it is determined that Seufert's system, as stated in the rejection above, meets the claimed limitation "continuous damping between soft and hard damping".

Applicant further argues that element 60 of Seufert is not the same as Applicant's element 7 because Seufert provides "no mentioning anywhere in this reference patent to Seufert, that the element 60 is a by-pass bore with a constant non-variable flow cross-section." It is believed that Applicant also provides no mentioning anywhere that the element 7 is a by-pass bore with a constant non-variable flow cross-section. This claimed limitation however is illustrated as element 7 in Figure 1 of the instant application in exactly the same way as element 60 is illustrated in figure 1 of Seufert. Applicant further argues that Seufert discloses in column 5, lines 53-59, that "A throttling path may be formed for example by one valve impinged by a spring."; therefore, element 60 of Seufert can be formed as a valve impinged by a spring. This passage of Seufert is considered as a teaching of an alternative embodiment of another well known way to restrict flow as stated in the rejection above in the combination of Preukschat in view of Seufert.

Applicant further argues that Preukschats' system does not provide any continuous damping. Preukschat clearly states in column 2, lines 20-26, "To achieve these and other objects of the invention, a preferred embodiment thereof includes at least two damping elements, which can be switched either individually or jointly, and which each have a valve assembly for decompression damping and a valve assembly

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for compression damping, **with different levels of damping** characteristic for each.”

Claims 1 and 11 claim “said flow resistance being continuous for providing continuous damping between soft and hard damping”. It is believed that switching the valves to provide different levels of damping characteristics would encompass from soft to hard damping. In order to further understanding the logic behind Applicant’s argument, the specification was further reviewed to determine the distinction between Applicant’s claimed continuous damping and Preukschat’s different levels of damping, it is found that there are no further explanation nor illustration to describe the meaning of “continuous” to be any different than Preukschat’s. Hence, it is determined that Preukschat’s system, as stated in the rejection above, meets the claimed limitation “continuous damping between soft and hard damping”.

Based on the reasons above, the rejections are still deemed proper and are repeated above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is (571) 272-7121. The examiner can normally be reached on M-F, 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on (571) 272-6786. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lan Nguyen
Primary Examiner
Art Unit 3683

Lan Nguyen 10/27/05